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**DEC 08 2004**

**OFFICE OF PETITIONS**

In re Application of	:	
Reamon et al.	:	
Application No. 09/705,134	:	DECISION GRANTING
Filed: November 2, 2000	:	PETITION
Attorney Docket No. 535352000500	:	

This is a decision on the petition under 37 CFR 1.47(a) filed September 27, 2004 (certificate of mailing September 24, 2004), which is being treated as a petition under 37 CFR 1.183 to waive the requirement under 37 CFR 1.131 that all of the inventors sign the declaration of prior inventorship.<sup>1</sup>

The petition under 37 CFR 1.183 is GRANTED.

A non-final Office action was mailed on March 24, 2004. This office action set a shortened statutory period for reply of three months, with extensions of time obtainable under 37 CFR 1.136(a).

In response, on September 27, 2004 (certificate of mailing September 24, 2004), applicants submitted a response, including a declaration under 37 CFR 1.131. This reply was made timely by an accompanying request and fee for extension of time for response within the third month. The 37 CFR 1.131 declaration states: "Prior to at least December 30, 1998, [the joint inventors] had formed a complete and operative idea of a point of interest spatial speech method and system." The 37 CFR 1.131 declaration was signed by all of the joint inventors, except inventor Nick Elmi. Applicants filed the present petition to have the 37 CFR 1.131 declaration accepted despite the fact that the declaration

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<sup>1</sup> 37 CFR 1.47 only applies when an inventor refuses to sign the original 37 CFR 1.63 oath or declaration.

was not signed by joint inventor Elmi. Applicants asserted that inventor Elmi was unwilling to execute the declaration.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the **inventor** of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.<sup>2</sup>

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."<sup>3</sup>

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicants do not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR 1.131 declaration include all of the joint inventors.

For a petition under 37 CFR 1.183 to be granted to waive the requirement that joint inventor Elmi sign the § 1.131 declaration, applicants must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

In the present petition, applicants set forth the steps taken to obtain joint inventor Elmi's signature on the § 1.131 declaration. Applicants have shown that the § 1.131 declaration and supporting documentation were presented to inventor Elmi for his signature. Applicants stated that inventor Elmi informed them that he refused to sign the § 1.131 declaration under the advise of his attorney.

The § 1.131 declaration presented is signed by joint inventors Reamon, Linder and Hirata. Under the circumstances, it is

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<sup>2</sup> 37 CFR 1.131(a) (emphasis added).

<sup>3</sup> MPEP 715.04.

concluded that petitioner has demonstrated that this is an extraordinary situation requiring waiver of the rules.

This matter is being forwarded to Technology Center Art Unit 2817 for consideration on the merits of the reply and the 37 CFR 1.131 declaration, filed September 27, 2004.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

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